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Date: March 29, 2006

Must Be Sent By:

To: Examiner: Pyzocha, Michael J.
Art Unit: 2137

Fax No: (571) 273-8300

Company: U.S. Patent & Trademark Office

Phone No:

From: Mark J. Danielson

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User No: 13068

C/M No: 010942-0269227

Re: U.S. Serial No. 09/732,333
Filing Date: December 6, 2000
First Named Inventor: Roger D. Pirkey et al.

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Attachments:

1. Transmittal for Pre-Appeal Brief Request for Review
2. Notice of Appeal
3. Pre-Appeal Brief Request for Review

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Roger D. Pirkey et al.

Confirmation No. 1489

Serial No.: 09/732,333

Examiner: Pyzocha, Michael J.
Art Unit: 2137

Filed: December 6, 2000

Atty Docket No. 010942-0269227
AWT-002

For: Enhanced PIN-Based Security Method and Apparatus

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By: Bobbie Juras
Bobbie Juras**TRANSMITTAL FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW**Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the Office Action mailed February 02, 2006 for which a response is due May 2, 2006. No amendments are being filed with this request.

The Commissioner is authorized to charge any required fee to Pillsbury Winthrop Shaw Pittman LLP's deposit account no. 03-3975 (order no. 010942-0269227). This request is being filed with a Notice of Appeal, which is proper because the claims have been finally rejected. The review is requested for the reason(s) stated on the attached sheets.

Respectfully submitted,
PILLSBURY WINTHROP SHAW PITTMAN LLPDate: 3/29/06Mark J. Danielson
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40,580

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Roger D. Pirkey et al.
Serial No. 09/732,333
700015217v1Pre-Appeal Brief Request for Review
010942-0269227 / AWT-002

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants incorporate and restate prior arguments made in response to rejections made in previous Office Actions. Claims 1-2, 4-6, 9, 11-13, 16-17, 19-21, 24, 26-28, and 31-41 are pending in the application. Claims 1, 9, 16, and 24 are independent claims.

Independent claim 1 explicitly requires (with similar limitations in claims 9, 16, and 24):

A method for providing access to resources with the use of personal identification numbers, comprising the steps of:

receiving a request from a subscriber to access a resource;

[1] **first comparing the resource to a system-wide list associated with a plurality of subscribers regardless of subscriber identity;**

if the resource is included in the system-wide list:

providing or denying access to the resource in accordance with the system-wide list;

if the resource is not included in the system-wide list:

[2] **next comparing the resource to a list associated with the subscriber that is separate from the system-wide list;**

Thus, independent Claims 1, 9, 16, and 24 clearly require:

- The concurrent maintenance of both a system-wide list associated with a plurality of subscribers and a list associated with the subscriber that is separate from the system-wide list,
- A progression of first comparing the requested resource to a system-wide list associated with a plurality of subscribers and next comparing the requested resource to a list associated with the subscriber that is separate from the system-wide list.

Neither Nor Rosenthal, Chiniwale, Alone or In Combination, Disclose or Suggest All Claim Limitations

Independent claims 1, 9, 16, 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,737,701 Rosenthal et al. ("Rosenthal") in view of U.S. Patent No. 6,175,622 Chiniwala et al. ("Chiniwala"). As set forth more fully below, since Rosenthal and Chiniwala, alone or in combination, do not meet all the limitations of independent claims 1, 9, 16, and 24, the Examiner has not established a prima facie case of obviousness. MPEP 2143.03.

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Neither Chiniwala Nor Rosenthal Teach The Concurrent Maintenance Of A Separate System-Wide List Associated With A Plurality Of Subscribers Regardless Of Subscriber Identity And A Separate List Associated With A Particular Subscriber.

The independent claims all require maintenance of a **distinct** and **separate** system-wide list associated with a plurality of subscribers regardless of subscriber identity **which is maintained concurrently** with a **distinct** and **separate** list that is associated with a particular subscriber. The Office Action relies on Chiniwala for meeting the limitation of a system wide-list, and Rosenthal for meeting the limitation of a list associated with a particular subscriber.

However, neither Chiniwala nor Rosenthal teaches the maintenance of **both distinct and separate** lists **concurrently** within the same system. Instead, Chiniwala and Rosenthal suggest the maintenance of only one of the lists at the exclusion of the other.

Specifically, Chiniwala teaches the maintenance of a White List and a Black List. The White List consists of numbers which end users can only place calls to, while the Black List consists of numbers which end users cannot place calls to. Both lists "may be common to all users or they may be organized into groups...."(col. 8 lines 40-41.) Thus, Chiniwala suggests **either** the maintenance of a list that is common to all users **or** a list that is associated with a particular group of users. It suggests the maintenance of a system-wide list at the exclusion of maintaining a more specific calling list associated with a group. Chiniwala does not suggest maintaining a separate system-wide call list **in addition and concurrently** with a list associated with a specific user. Since Chiniwala suggests the maintenance of a system-wide list at the exclusion of maintaining other lists, Chiniwala does not teach, nor suggest the concurrent maintenance of both a separate and distinct system-wide list and a list associated with a specific user. Thus, Chiniwala fails to teach the limitations of claims 1, 9, 16, and 24.

In addition, Rosenthal teaches the maintenance of a list of numbers which are associated with "identification information associated with the call, such as the MIN/ESN of a subscriber's wireless telephone set, or the calling card number provided by a calling card subscriber." (col. 3 lines 9-14.) Rosenthal is solely directed to the maintenance of lists associated with specific user characteristics. Nothing in Rosenthal suggests maintaining a user specific list **in addition and concurrently** with a system-wide list associated with a plurality of users. Thus, Rosenthal also fails to teach the limitations of claims 1, 9, 16, and 24.

Neither Chiniwala nor Rosenthal Teaches First Comparing The Requested Resource To A System-Wide List Associated With A Plurality Of Subscribers And Next Comparing The Requested Resource To A List Associated With The Subscriber That Is Separate From The System-Wide List.

The independent claims all require that after receiving an access request for a resource from a subscriber, the steps of the method are to **first** compare the requested resource to a system wide list associated with a plurality of subscribers and to **next** compare the resource to a list associated with the subscriber. Neither Chiniwala nor Rosenthal teaches such a progression of comparison.

Chiniwala specifically teaches the maintenance of a White List and a Black List which are either associated with all users or groups of users. The White List consists of numbers which end users can only place calls to, while the Black List consists of numbers which end users cannot place calls to. (col. 8 lines 39-54.) Nothing in Chiniwala suggests that the White List or Black List must be compared to **first** before any other list. In fact, as described above, Chiniwala teaches the maintenance of a list associated with all users to the exclusion of all other lists. Thus, it would be logically impossible for Chiniwala to teach any limitations regarding **first** comparing to a system-wide list. Since Chiniwala does not disclose the limitation of **first** comparing the requested resource to a system-wide list associated with a plurality of subscribers and **next** comparing the requested resource to a list associated with the subscriber that is separate from the system-wide list, Chiniwala fails to teach the limitations of claims 1, 9, 16, and 24.

Rosenthal teaches the maintenance of a list of numbers which are associated with "identification information associated with the call, such as the MIN/ESN of a subscriber's wireless telephone set, or the calling card number provided by a calling card subscriber." (col. 3 lines 9-14.) Thus, Rosenthal is solely directed to the maintenance of lists associated to specific user characteristics. Nothing in Rosenthal suggests that the specific user lists must be compared to **after a comparison to a system-wide list**. Since Rosenthal does not disclose the limitations of **first** comparing the requested resource to a system-wide list associated with a plurality of subscribers and **next** comparing the requested resource to a list associated with the subscriber that is separate from the system-wide list, Rosenthal fails to teach the limitations of claims 1, 9, 16, and 24.

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The Alleged Combination Of Rosenthal and Chiniwala Would Not Suggest the Claimed Invention

The independent claims all require the maintenance of a **distinct** and **separate** system-wide list associated with a plurality of subscribers regardless of subscriber identity **which is maintained concurrently** with a **distinct** and **separate** list that is associated with a particular subscriber, and a progression of comparison which specifies **first** comparing the requested resource to a system wide list associated with a plurality of subscribers and **next** comparing the requested resource to a list associated with the subscriber.

Chiniwala merely teaches the maintenance of a White List and a Black List which either is associated with all users or groups of users. Rosenthal merely teaches maintenance of lists associated to specific user characteristics.

Since neither Chiniwala nor Rosenthal teach or suggest the **concurrent** maintenance of **both** a system-wide list and a user specific list, or the progression of **first** comparing the requested resource to the system-wide lists, and **next** comparing the requested resource to a user specific list, the alleged combination of Chiniwala and Rosenthal would not suggest all the limitations of independent claims 1, 9, 16, and 24 even if they could be combined as alleged in the Office Action. Accordingly, Applicants submit independent claims 1, 9, 16, and 24, together with claims 2, 4-6, 11-13, 16-17, 19-21, 24, 26-28, and 31-41 that depend therefrom, patentably define over Chiniwala and Rosenthal.

No Other Cited Prior Art Cures the Deficiencies of Chiniwala and Rosenthal With Respect to Independent Claims 1, 9, 16, and 24.

Claims 5, 12, 20, 27, 33, 36, 39, and 42 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Rosenthal and Chiniwala in view of US Patent 6,330,311 Mijares et al. ("Mijares"). Claims 31, 34, 37, and 40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenthal and Chiniwala in view of Rowell et al, WO 9704602 ("Rowell"). Claims 32, 35, 38, and 41 stand rejected as being allegedly unpatentable over Rosenthal and Chiniwala in view of Rudokas, US Patent 5420910 ("Rudokas"). These claims depend ultimately from independent claims 1, 9, 16, and 24 and thus are patentable for at least the reasons presented above. The deficiencies noted above are not cured by the alleged combinations with Mijares, Rowell, or Rudokas. Neither Mijares, Rowell, nor Rudokas teach or

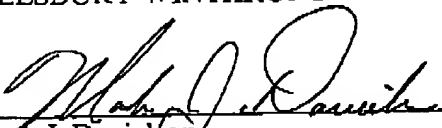
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suggest the **concurrent** maintenance of **both** a system-wide list and a user specific list, or the progression of **first** comparing the requested resource to the system-wide list, and **next** comparing the requested resource to a user specific list as required by claims 1, 9, 16, and 39.

For at least the foregoing reasons, the rejections of the claims are improper and should be withdrawn.

Respectfully submitted,
PILLSBURY WINTHROP SHAW PITTMAN LLP

Date: March 29, 2006


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